

REMARKS

This Application has been reviewed in light of the Office Action mailed on March 26, 2009. Claims 1, 3–8, 10, 11, and 13–17 are pending in the application. Claims 1–2, 7–12, and 17 have been canceled. Claims 3–6 and 13–16 have been amended and Claims 18–28 are new. While the original independent claims have been canceled, Claims 18, 23, 25, and 27 generally recite similar claim elements as the canceled claims, as well as additional elements. New matter, however, has not been added with the new or amended claims. Applicant respectfully requests reconsideration of the application in accordance with the following remarks.

Section 103 Rejections

Claims 1, 3–8, 10, 11, and 13–17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0069179 to Slater *et al.* (“*Slater*”) in view of U.S. Patent No. 6,634,559 to Shioda (“*Shioda*”). Applicant respectfully traverses the rejection and assertions and holdings therein, because the above cited art, whether individually or in combination, fails to teach, suggest, or disclose certain aspects of the present claims, including, for example, Claim 18.

Put simply, *Slater* and *Shioda* fail to teach implementing a workflow system that generates printed out documents sent to and for use with external entities that do not exchange electronic documents with the workflow, but that then receives a modified version of the printed out document back from the external entity for reintegration into the workflow after validating the modified and printed out document. For instance, *Slater* is directed towards a system for generating, by electronic means, a legally enforceable document. *Slater* fails to teach receiving modified print outs from external entities outside the workflow and reintegrating the received print outs back into the workflow. The legal documents of *Slater* do not leave the workflow, and more to the point, the printed out version of the legal document is not modified by an external entity or reintegrated into the workflow with the modification. Similarly, *Shioda* also does not teach receiving a modified print out, validating the modified print out using existing validation information on the print out, and reintegrating the modified print out back into a workflow. In addition, both references fail to teach, whether alone or in combination, generating control codes including second control codes generated from the canonical form of the text content.

Turning to specific limitations missing from the cited references, the *Slater-Shioda* combination fails to teach “sending the print out to the external entity,” “receiving a modified print out at the workflow system back from the external entity, the modified print out comprising the print out sent to the external entity with a modification,” “validating the modified print out within the workflow system using the one or more control codes,” and “integrating the modified print out into the workflow,” as recited by example Claim 18.¹

At best, *Shioda* teaches printing a data sheet, scanning or copying it for decoding, erasing information recorded on the data sheet, and printing new information to the data sheet. *See Shioda*, 26:36–27:14. In other words, *Shioda* fails to teach that the print out is sent to an external entity, modified, and returned to the workflow containing the modification as well as the original text content and control codes.² Instead, *Shioda* merely teaches a datasheet that requires the datasheet medium to be heated to a fixed temperature in order to be erased or altered. *See Shioda*, 27:3–14. Heating the medium would erase the content previously displayed on it, rendering that content lost, since the medium would then be used for reprinting. *See Shioda*, 27:10–14.

Shioda also fails to teach that upon receiving the modified print out, the modified print out is validated using the control codes appearing thereon, and integrated back into the workflow. In fact, *Shioda* does not teach content validation using control codes. *Shioda* merely teaches that the “codes [are] used by a reading device for confirming a password for the printed matter, permitting the printed matter only to be printed, enabling only creation of a file or only fax of the file, or letting a holder of the printed matter select a process among several processes by displaying a menu.” *Shioda*, 6:59–64. Second, *Shioda* fails to teach integrating the modified print out back into the workflow. For example, the data sheet taught by *Shioda* is a rewritable data sheet. *Shioda* teaches that during the printing process, “the control device erases

¹ Applicant objects to the Office Action taking official notice that receiving documents in the printed form, scanning documents to create an electronic form, and processing the electronic document in a workflow system were obvious.

² Furthermore, *Shioda* fails to teach that the print out is sent to an external entity, received at the workflow system from the external entity, the print out having a human signature added subsequent to sending the print out to the external entity, validated using the one or more control codes, and integrated into the workflow, as recited in Claim 27.

information recorded on the medium by heating the medium to a fixed temperature. . . . Taking the step, the control device prints information on the medium, to which the step has been performed, by heating the medium to a fixed temperature.” *Shioda* 27:3–13 (internal references omitted). As such, in printing the data sheet of *Shioda*, the original contents of the data sheet are erased.³

Slater fails to overcome the various deficiencies of *Shioda*. For example, *Slater* fails to teach, at least, sending a print out to an external entity and receiving the print out at the workflow back from the external entity, validating the received print out, and integrating the print out into the workflow as recited in Claim 18. Specifically, *Slater* only teaches printing an electronic document at one point in its disclosure:

“In addition, each signer often desires a copy of what they digitally signed. This can be accomplished by emailing the document to the signer after it has been signed, by printing a signed version of the document, saving a copy of the document's current stage to a disk, and the like. This enables each signer to compare the document that is ultimately recorded with the document as it existed when they signed it.”

Slater ¶ 64. In other words, *Slater* merely teaches that a signer of the electronic document can print a copy of it *before the electronic document* is signed by the notary or the recorder. Thus, the printed electronic document would contain either the one or more first control codes or the one or more second control codes because the electronic document from which the print out is based has yet to be routed through the entire workflow. Furthermore, *Slater* does not teach that the printed document could be received at the workflow following a modification to the printed document itself by the external entity, wherein the modified printed document is then validated and integrated back into the workflow. In fact, *Slater* teaches away from this notion because *Slater* is directed to generating a legally enforceable document by entirely electronic means. See *Slater* ¶ 6 (“[T]he characteristics (such as authenticity and security) are arguably better than their paper counterparts.”); see also *id.*, Abstract, ¶¶ 7, 11.

³ Furthermore, *Shioda* teaches away from printing out documents. For example, *Shioda* teaches that “with recent advancement of computers and network technologies, consumption of paper by printers and the like has increased. With such increased consumption of paper, destruction of forests, a garbage disposal problem, a temperature rise caused by an increase in an amount of carbon dioxide in the air, and the like, so called environmental problems have been occurring. Accordingly, it is requested to reduce the consumption of paper.” *Shioda*, 1:53–60.

Additionally, *Slater* does not teach that the print out is validated upon receipt from the external entity using control codes affixed to the print out. To the contrary, *Slater* teaches that the electronic document can be printed out by a signer before the electronic document is signed by the notary or recorded and before the electronic document is routed through the entire workflow. *See Slater* ¶ 64. Moreover, the print out discussed in *Slater* does not contain one or more first or second control codes from which the print out can be validated.

Further, Applicant submits that neither *Slater* nor *Shioda*, taken alone or in combination, teaches “generating control codes for the electronic document as part of a workflow in the workflow system, the control codes including . . . one or more second control codes generated from the canonical form of the text content.” At best, *Slater* teaches adding digital signatures to an electronic document by a primary signer, a notary, or recorder to create a legally enforceable electronic document, while *Shioda* merely teaches barcodes represent planned processes encoded by the creator of the datasheet.

The Office Action argues that *Slater* teaches generating one or more second control codes generated from the canonical form of the text content by teaching “signing the entire document, for example by a notary or recorder after primary signers sign the document. The signature by notary or recorder applies to the content of the document, which . . . includes a canonical converted text.” This argument, however, fails to show that *Slater* teaches generating control codes from the canonical form of the text content. Rather, this argument merely advances the notion that the digital signature of the notary or recorder is applied to the text. The digital signatures of the notary and recorder are added to the electronic document after it is signed by the primary signer. *See Slater* ¶¶ 44–48. For example, *Slater* teaches that “[a]fter the content has been entered, the document is digitally signed (252) by one or more persons who are indicated in or on the electronic document.” *Slater* ¶ 44. “After all of the digital signatures have been obtained and inserted, the electronic document is digitally notarized (253).” *Slater* ¶ 45. Nowhere in *Slater* does it teach generating a control code from the canonical form of the text content. Furthermore, nowhere in *Slater* does it teach including the one or more second control codes generated from the canonical form of the text content on a print out of the signed electronic document.

Shioda fails to overcome the deficiencies of *Slater* with regards to this element. The Office Action argues that *Shioda* teaches barcodes representing control codes. See Office Action, Mar. 26, 2009, at 4. The barcodes of *Shioda*, however, are not analogous to at least the second control codes of the present application. The barcodes taught by *Shioda* are “used by a reading device to perform processes planned by a creator of the printed matter.” *Shioda*, 6:57–59. In its discussion of barcodes, *Shioda* fails to teach or suggest that the barcodes represent control codes generated from the canonical form of the text. Therefore, neither *Slater* nor *Shioda*, taken individually or in combination, teaches generating control codes for the electronic document, the control codes including one or more second control codes generated from the canonical form of the text content as recited in Claim 18.

Accordingly, the *Slater-Shioda* combination fails to teach, suggest, or disclose each and every element recited in example Claim 18. For at least these reasons, Applicant respectfully requests withdrawal of the § 103 rejections, as well as reconsideration and allowance of Claim 18 and its dependents. Further, independent Claims 23, 25, and 27 recite certain elements analogous to those of Claim 18. For at least reasons similar to those discussed with regard to Claim 18, independent Claims 23, 25, and 27, as well as their dependents, are also allowable over the *Slater-Shioda* combination. Thus, Applicant respectfully requests that the rejections of those claims also be withdrawn and the claims be allowed.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. It is believed that all of the pending claims have been addressed. Applicant notes that the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all Claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

No fee is believed to be due. However, if this is incorrect, please apply any required fees or credits to PTO Deposit Account No. 06-1050, referencing the above attorney docket number.

Respectfully submitted,

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